SUPREME COURT, U. S.
APR 8 1974
MICHAEL RODAK, JR., CLERK

IN THE SUPREME COURT OF THE UNITED STATES

OCTOBER TERM 1973

NO. 73-1092

MRS. WINSTON CALDWELL, Administratrix
and JAMES J. SHANLEY, Petitioners

v.

UNITED STATES OF AMERICA

ON PETITION FOR WRIT OF CERTIORARI
TO THE UNITED STATES COURT OF CLAIMS

PETITIONERS' REPLY TO BRIEF IN OPPOSITION

FRENCH CALDWELL
2912 Larchmont Street
Pascagoula, MS 39567
Attorney for Petitioners

Of Counsel:
Paul T. O'Neil
SHANLEY & O'NEIL
2233 Wisconsin Avenue
Washington, D.C. 20007

IN THE SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1973

NO. 73-1092

MRS. WINSTON CALDWELL, Administratrix
and JAMES J. SHANLEY, Petitioners

v.

UNITED STATES OF AMERICA

ON PETITION FOR WRIT OF CERTIORARI
TO THE UNITED STATES COURT OF CLAIMS

PETITIONERS' REPLY TO BRIEF IN OPPOSITION

The Court of Claims held the Caldwell patent invalid as being "obvious" under the standard of 35 USC 103. This petition presents three specific questions directed to errors of law committed by the court in reaching this holding.

The opposing brief would amend the petition's three questions and substitute the single broad question: Whether or not the Court of Claims properly held that the Caldwell invention was "obvious"? (Opposing Brief, p. 2) As seen below, rephrasing the question does not change the issues of the case, but raises new errors not heretofore challenged in the petition.

The Presumption of Validity

The Court of Claims casually set aside the presumption of validity that is accorded to issued patents under 35 USC 282. Even though the court's reasoning is an exact repitition of the Patent Office remarks of twenty years ago (App. 24), respondent contends that the court was "correct".

Assuming, arguendo, that the court was correct, **the demise of the presumption of validity does not relieve the court of its duty to comply with the requirements laid down by this Court in Graham v. John Deere Co. (Petition Question 2).** Respondent has simply raised another question.

Incomplete Findings of Fact

Although the petition is directed only to errors of law committed by the court below, respondent contends that: "Petitioners challenge the court's finding of fact that prior art references clearly disclose and make obvious Caldwell's alleged invention."

The Court of Claims did not make any **finding of fact** that the invention was "obvious" (App. 13-39), but only made statements to this effect in the opinion.

This Court held in **United States v. Robert Esnault-Pelterie**, 299 US 201, reversing 81 C. Cls. 785, that special findings of fact on the ultimate issues of validity and infringement are mandatory; and that **the findings of fact may not be aided by statements in the conclusion of law or the opinion of the Court of Claims.**

As the required special findings of fact were not made, the judgement below cannot be sustained.

The Prior Art

In paragraphs 1. and 2. of its argument, respondent asserts that some or all of the elements of the patented invention were individually known to the prior art before 1953 when the patent application was filed. Respondent particularly emphasizes a single element - electrode spacing. The patent claims in suit (App. 20-22) clearly describe a combination invention meeting the standard of 35 USC 112. The fact that one, some or all of the separate elements of the combination were individually known prior to 1953 cannot make "obvious" a patent for the combination. **U.S. v. Adams,** 86 S. Ct. 708, 383 U. S. 39.

CONCLUSION

This petition for writ of certiorari should be granted.

Respectfully submitted,

FRENCH CALDWELL
Attorney for Petitioners